

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing Amendment, Claims 1, 9, and 34-35 have been amended, and Claim 2 has been canceled without prejudice or disclaimer. Claims 24-33 have been withdrawn as drawn to an unelected invention, and Claims 13-19 and 21-23 have been withdrawn as drawn to an unelected species. No new matter has been added. Thus, Claims 1, 3-12, 20 and 34-45 are pending and subject to examination.

### **Claims Rejected—35 U.S.C. § 112**

In the Office Action mailed February 15, 2006, claims 1-12, 20 and 34-45 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 1 is rejected because the Office Action argues that the step of approving the budget does not relate to the "other method steps of the claim concerning the work and invoicing." Claims 4-8 are rejected for the same reasons as Claim 1. Applicants have amended Claim 1 responsive to the rejection. Claims 4-8 depend from Claim 1. Accordingly, the Applicants respectfully submit that Claims 1 and 4-8 are now definite and, thus, particularly point out and distinctly claims the subject matter which the applicant regards as the invention.

As mentioned above, by this Amendment, Claim 2 is canceled without prejudice or disclaimer, rendering the rejection thereof moot.

The Office Action argues Claims 9-12 are indefinite because "receiving a confirmation" does not relate to any process steps of Claim 1. Claim 9 is amended

responsive to the rejection. Claims 10-12 depend from Claim 9. Therefore, the Applicants respectfully submit that Claims 9-12 are definite.

Accordingly, the Applicants respectfully request withdrawal of the rejection.

**Claims Rejected—35 U.S.C. § 103**

Claims 1-12, 20 and 34-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0111842 to Miles (“Miles”) in view of U.S. Patent Publication No. 2004/0064389 to Force et al. (“Force”). The Applicants note that Claims 1, 9, and 34-35 have been amended. To the extent the rejection remains applicable to the claims, as amended, the Applicants respectfully traverse the rejection as follows.

The Office Action, at page 4, lines 2-5, asserts that Miles teaches: “Creating work order to two or more vendors, transmitting the work order to the vendor electronically, receiving invoice information from the vendor, approving the work order and approving the initiating payment of the approved invoice to the vendor (refer to para [sic] [007] through [0011]).”

The Applicants respectfully disagree. The Applicants have thoroughly reviewed paragraphs [0007] through [0011] of Miles, cited in the Office Action, and were unable to identify any teaching or suggestion of at least the following limitations of amended Claim 1: creating a budget for a transaction, the budget including a total price and at least one line item, each line item including an approved work order price; if the budget does not exceed a budget maximum: approving the budget; creating a work order for each line item, each work order specifying a vendor to complete the work order; receiving invoice information from the vendor, the invoice information including an invoiced price; if the

invoiced price is not greater than the approved work order price or a preset overage tolerance, approving the invoiced price; and initiating payment of the approved invoice price to the vendor.

The Applicants submit that such features are completely absent from Miles and notes that the Office Action has failed to particularly identify each of the features recited in Claim 1, as amended, with particularity, as required by applicable law and M.P.E.P. § 2142. The initial burden is on the Office Action to establish *prima facie* obviousness. *Id.* "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143.03. If the Office Action does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See M.P.E.P. § 2142.

The Office Action asserts that Force overcomes the deficiencies of Miles. However, the Applicants have reviewed Force and submit that Force does **not** teach or suggest at least the feature of initiating payment of an approved invoice price to a vendor, as recited in amended Claim 1.

As stated above, each and every feature of a claim must be taught or suggested by the prior art in order to establish *prima facie* obviousness. Therefore, because Miles and Force, either alone or in combination, do not teach or suggest each and every feature recited in amended Claim 1, for at least the reasons provided above, the Applicants respectfully submit that Claim 1 is allowable over the cited art.

Claims 2-12 and 20, as amended, depend from amended Claim 1 and, thus, incorporate each and every feature recited therein. Therefore, the Applicants

respectfully submit that Claims 2-12 and 20 are allowable for at least the same reasons amended Claim 1 is allowable, as well as for the additional subject matter recited respectively therein.

Applicants further submit that Miles and Force, either alone or in combination, do not teach or suggest each and every feature recited in amended Claims 34 and 35 for similar reasons explained above with respect to amended Claim 1.

Claims 36-45 depend from Claim 35. Thus, Applicants submit that Claims 36-45 are allowable for at least the same reasons Claim 35 is allowable, as well as for the additional subject matter recited respectively therein.

Further, both the case law of the Federal Circuit and the PTO itself has made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. *See also In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action asserts that the proposed motivation is:

incorporate this process of creating work order for each line item of the budget as per Force because this would enable integration of the budget process with the invoicing of each line items [sic] of the budget to a corresponding vendor and monitor the invoicing as per the prevailing business practices.

See the Office Action at page 4, lines 9-13. However, the Applicants respectfully submit that this is an improper motivation based on hindsight, as there is no suggestion to combine the references in the prior art, nor does the Office Action identify any other alleged objective motivation in the pertinent art to motivate one of ordinary skill to modify Miles and Force, as asserted in the Office Action. Such a motivation is completely absent.

As stated above, the Office Action bears the burden of establishing *prima facie* obviousness. M.P.E.P. § 2142. Therefore, for at least these reasons, the Applicants respectfully submit that the Office Action has failed to do so.

Therefore, the Applicants respectfully request withdrawal of the rejections.

### **Conclusion**

For all of the above reasons, it is respectfully submitted that the claims, now pending, patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, **referring to client-matter number 026083-00005.**

Respectfully submitted,



Darien Reddick  
Attorney for Applicants  
Registration No. 57,956

Enclosures: Petition for Extension of Time  
Check No. 447771

**Customer No. 004372**

ARENT FOX PLLC

1050 Connecticut Avenue, N.W., Suite 400

Washington, D.C. 20036-5339

Tel: (202) 715-8469

Fax: (202) 638-4810

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